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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,364	01/14/2002	Joachim Wagenblast	Mo6655/LeA 33,721	5085

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NORDMEYER, PATRICIA L

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1772

DATE MAILED: 04/23/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/047,364	WAGENBLAST ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) 5 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                          | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to because of the following informalities: The claim contains the abbreviations "PSO and PEEK". To ensure what is being claimed, it is desired that the abbreviations be written out into their full form. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 3, 6 – 10 and 12 – 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bien (USPN 4,973,102).

Bien discloses a core body made from metal with a plurality of perforations (Column 5, lines 58 – 60 and Figures 3 and 5, #16). A plastic part made from thermoplastic material rests against the metal body (Column 6, lines 1 – 4 and Figures 3 and 5, #14). The two pieces are joined together by joining elements, bolts (Column 5, lines 66 – 68 and Figure 4, #39) or rivets (Figure 4, #72) that extend perpendicularly through the perforations. The openings and joining elements allow the plastic panel to slide relative to the metal substructure due to different thermal expansion characteristics (Column 3, lines 11 – 17). The metal strip contains elongated holes (Figure 3 and 6, #24a-d and Column 5, lines 46 – 48), which allows for thermal expansion

of the plastic part (Column 4, lines 12 – 17). As can be seen in Figure 5, the openings have a larger dimension in both the x and y directions than the joining elements to allow for expansion. A circular hole (Figure 6, #27) exists in the metal strip as a fixed joining element since both holes have matching diameters (Column 7, lines 60 – 62). The article formed with the composite of plastic and metal is a structural article such as a part of an automotive vehicle body (Column 1, lines 5 – 11).

Regarding the limitation of injection molding the plastic portion on a part of the core body and the joining elements being formed at the same time in claim 9 and the limitation of prior to injection molding, the perforations being filled by removable cores to inhibit the edges of the perforations being embedded in plastics and then removing the cores in claim 10, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of injection molding and the steps that go with said process are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in

kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

4. Claims 1, 4 – 6, 7, 9 – 11, 14 and 14 rejected under 35 U.S.C. 102(b) as being anticipated by Muehlhausen (USPN 5,580,122).

Muehlhausen discloses a core body made from metal with a plurality of perforations (Column 2, lines 40 – 44 and Figures 1, #3 and 3'). A plastic part made from thermoplastic material is injection molded against the metal body (Column 2, lines 27 – 31 and Figures 2). The two pieces are joined together by thermoplastic material that flows through the openings in the metal sheets to act as anchoring points for the plastic (Column 2, lines 40 – 44). The openings and joining elements are configured to transmit loads without failing, allowing movement between the two pieces without failure (Column 1, lines 35 – 41). When the plastic is injection molded on to the metal body, ribs are formed where the perforations are located at the intersection of the ribs and the ribs give strength to the formed article (Figure 2, #6 and Column 2, lines 45 – 47). The thermoplastic material used in the composite is a glass fiber reinforced polyamide (Column 2, lines 62 – 65). Injection molded plastic forms a continuous rivet or joining element between the metal body and the plastic portion by extending perpendicular through the perforation in the metal body (Figure 2 and Column, lines 40 – 44). The article formed with the composite of plastic and metal is a structural article such as a part of an automotive vehicle body (Column 1, lines 7 – 10).

Regarding the limitation of injection molding the plastic portion on a part of the core body and the joining elements being formed at the same time in claim 9 and the limitation of prior to injection molding, the perforations being filled by removable cores to inhibit the edges of the perforations being embedded in plastics and then removing the cores in claim 10, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of injection molding and the steps that go with said process are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-

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5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

pln  
pln

April 15, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  


4/17/03